



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/589,761

10/17/2007

Martin Schweizer

7865-304 MIS

2241

24223 7590 10/18/2011

SIM & MCBURNEY  
330 UNIVERSITY AVENUE  
6TH FLOOR  
TORONTO, ON M5G 1R7  
CANADA

EXAMINER

SAYALA, CHHAYA D

ART UNIT

PAPER NUMBER

1781

MAIL DATE

DELIVERY MODE

10/18/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,761	<b>Applicant(s)</b> SCHWEIZER ET AL.	
	<b>Examiner</b> C. Sayala	<b>Art Unit</b> 1781	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/27/2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 37-39 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 37-39 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### ***Claim Rejections - 35 USC § 102/ Claim Rejections - 35 USC § 103***

1. Claims 37-39 are rejected under **35 U.S.C. 102(a)** as anticipated by or, in the alternative, under **35 U.S.C. 103(a)** as obvious over WO 03088760.

WO 03/088760 discloses a canola protein isolate that has a protein content of at least about 90 wt% on a dry weight basis and has a protein profile which is: about 60 to about 98 wt % of 7S protein, about 1 to about 15 wt % of 12S protein, and 0 to about 25 wt % of 2S protein. (claim 4). This reads on the protein isolate of claim 37. Since claim 38 depends from claim 37, then this claim is anticipated as well. The canola protein

Art Unit: 1781

isolate is the same and reciting that it is now a feed does not lend patentability to an otherwise old product. Further, since the canola protein isolate is the same, its protein profile is an inherent feature or characteristic, whether or not applicant has devised ways and means to separate its components. The claims are being rejected under both statutes of 35 USC 102 and 103 because the protein profile disclosed is not exactly the same and even if it were not the same, it would still be obvious over the patented product, because it is the protein isolate that is being claimed and the profile is being used to describe it insofar as applicant has found means to differentiate and name its various components. Claim 39 is likewise rejected because it recites a product that is already old and known. Further, to the extent disclosed in the instant specification, "formulation" is to the canola protein isolate itself, since no other particular formulation is disclosed therein, as recited in claim 39.

2. Claims 37-39 are rejected under **35 U.S.C. 102(a)** as anticipated by or, in the alternative, under **35 U.S.C. 103(a)** as obvious over WO02/089597.

At page 36, the patent recites a canola protein isolate that has a protein content of at least about 90 wt%. See claims 37-38. The protein profile is not given and neither does the Office have the resources to manufacture prior art products and make such comparisons. That burden is being shifted to applicant to determine whether the protein product being claimed as "a canola protein isolate" is the same or is obvious over the claimed product. Note too that the intended use language does not render these claims patentable. See *In re Thuaau* 57 USPQ 324; *In re Zierden*, 162 USPQ 102. Further, to

the extent disclosed in the instant specification, "formulated" is to the canola protein itself, since no particular formulation is disclosed or described therein. As recited, the canola protein isolate of the reference is being held as the same since the protein profile of the isolate is an inherent characteristic, and applicant has chosen to describe the same canola isolate by its profile of the various protein components.

### ***Response to Arguments***

Applicant's arguments filed 9/27/2011 have been fully considered but they are not persuasive.

Applicant has argued that the WO '597 patent does not disclose the protein profile of the canola protein isolate now claimed. He states that the PMM was separated but the reference does not provide the protein profile of the analysis. As described above, the canola protein isolate of the preamble is nonetheless the same, whether the profile was described or not because the profile is an inherent property of the protein isolate and, as can be discerned from claim 38 which is dependent from claim 37 to the same canola protein isolate, the profile can vary according to the procedure and methods used to separate the components. However, it is the same isolate of the preamble, and applicant has not shown this to be otherwise. With regard to claim 39, the specification lacks a clear description of *any* formulation and therefore, this claim has been treated as if it were drawn to the isolate itself. Intended use limitations carry little weight in patentability determination. These same arguments hold good with respect to the WO '760 reference as well. Applicant is reminded that the

Art Unit: 1781

patentability of these product claims herein are not predicated upon applicant refining his method of finding profiles of varying scope, of the same canola protein isolate.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1781

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/C. SAYALA/  
Primary Examiner, Art Unit 1781**